UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,383	09/24/2001	Guenter Hahn	2000P18622 US	7489

7590 01/28/2004

YOUNG & THOMPSON
Second Floor
745 South 23rd Street
Arlington, VA 22202

EXAMINER	
MANTIS MERCADER, ELENI M	
ART UNIT	PAPER NUMBER
3737	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/960,383	Applicant(s) HAHN, GUENTER	
	Examiner Eleni Mantis Mercader	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sh et with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6 and 8-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6 and 8-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

FINAL ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 13-19 have been considered but are moot in view of the new ground(s) of rejection. The "self-test means" now introduced through claim 13 constitutes new grounds for rejection as it was not previously presented.

2. Applicant's arguments filed on 11/5/2003 have been fully considered but they are not persuasive. It seems that Applicant's comments are centered on the concept that the current invention is not an "expert system" providing solutions to a problem but rather it is an integral portion of the medical apparatus. However the current claims as written do not exclude such a system, for example there is no recitation of "consisting" rather, the transitional open term "comprising" is used. Furthermore, as illustrated in Figure 1 by element 70, the interface of a user/operator who is requesting the problem-solution is directly linked with the medical imaging apparatus (also see col. 5, lines 19-46; referring to either include it as part of the medical apparatus similar to the current invention's Figure 2 or it can be an external stand-alone station). In addition the current claims state nothing about imaging. Also, in the abstract the Babula et al.'914 reference clearly states that exemplary image descriptions are provided, implying that the operator will be able to solve the problem through these illustrations, and in col. 6, lines 1-28, trouble-shooting of the imaging system is one of the problem-solution inquiries. For at least these reasons the rejection is maintained.

3. The Applicant did not address the Double Patenting rejection. The rejection has been changed to address the newly added claims.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No. 10/287,359 in view of Pech et al.'397.

Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patently distinct from each other because they represent alternate variations and groupings.

The claims of Application No. 10/287,359 do not teach a self-test means for determining when a problem affecting the medical apparatus occurs.

In the same field of endeavor, Pech et al.'397 teach a self-test means for determining when a problem affecting the medical apparatus occurs (see col. 1, lines 47-67; col. 2, lines 24-67 and entire cols. 3-4; also in particular see col. 2, lines 1-6 clearly stating that this self-test means can be an integral component of the medical apparatus).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified the claims of Application No. 10/287,359 and incorporated the teachings

of Pech et al.'397 in order to identify the specific error of electrical or electromechanical components of the medical apparatus, such as the specific portion of the medical component which is malfunctioning (see for motivation to combine in Pech et al.'397, col. 1, lines 27-36).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3, 5-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babula et al.'914.

Regarding current claims 1, Babula et al.'914 teach a medical apparatus with means for dealing with problems which, when a problem affecting the medical apparatus occurs, determine that (those) component(s) which is (are) the cause of the problem concerned and display it (them) on a display device and the means of which for dealing with problems obtain problem-specific data on the medical apparatus with respect to the problem determined and evaluate them with regard to the component(s) causing the problem concerned (col. 12, lines 66-67 and col. 13, lines 1-41).

Babula et al.'914 teach a system wherein description on how to correct the problem with respect to the medical apparatus is provided (see Figure 10). It would have been obvious to one skilled in the art at the time that the invention was made that according to the particular system

certain components to be replaced could be performed by the operator instead of a service man. So, if an MRI surface coil is malfunctioning and the system displays such, the operator could in fact utilize an alternative surface coil and hence not require service repair at that particular timeframe.

Babula et al.'914 teach dealing with problems via telecommunication means (see col. 9, lines 5-13).

Regarding claim 3, the medical apparatus contains a data memory in which information serving for determining data is stored and taken from the data memory by the means for dealing with the problem on a problem-dependent basis (see col. 6, lines 45-50).

With respect to claims 5 and 8-10, it would have been obvious to a skilled artisan at the time that the invention was made that whether for use by a service man or by an operator, the components of expensive diagnostic equipment would be specifically labeled in order to avoid possible destruction by possible misuse and for the same reason it would have been obvious to one skilled in the art to run a test to determine that the component functions appropriately in order to avoid destruction to the rest of the system.

Regarding claims 6 and 11, the medical apparatus contains a data memory in which information serving for determining data is stored and taken from the data memory by the means for dealing with the problem on a problem-dependent basis (see col. 6, lines 45-50).

Regarding claim 12, Babula et al.'914 teach the apparatus being assigned a data memory in which at least partially graphic information concerning the exchange of components which can be presented on a display unit of the apparatus is stored (see col. 16, lines 1-13 and see Figure 11).

8. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babula et al.'914 in view of Pech et al.'397.

Babula et al.'914 teach all the elements of the current invention including a medical apparatus with means for dealing with problems which, when a problem affecting the medical apparatus occurs, determine that (those) component(s) which is (are) the cause of the problem concerned and display it (them) on a display device and the means of which for dealing with problems obtain problem-specific data on the medical apparatus with respect to the problem determined and evaluate them with regard to the component(s) causing the problem concerned (col. 12, lines 66-67 and col. 13, lines 1-41).

Babula et al.'914 teach a system wherein description on how to correct the problem with respect to the medical apparatus is provided (see Figure 10). It would have been obvious to one skilled in the art at the time that the invention was made that according to the particular system certain components to be replaced could be performed by the operator instead of a service man. So, if an MRI surface coil is malfunctioning and the system displays such, the operator could in fact utilize an alternative surface coil and hence not require service repair at that particular timeframe.

Babula et al.'914 teach dealing with problems via telecommunication means (see col. 9, lines 5-13).

The medical apparatus contains a data memory in which information serving for determining data is stored and taken from the data memory by the means for dealing with the problem on a problem-dependent basis (see col. 6, lines 45-50).

It would have been obvious to a skilled artisan at the time that the invention was made that whether for use by a service man or by an operator, the components of expensive diagnostic equipment would be specifically labeled in order to avoid possible destruction by possible misuse and for the same reason it would have been obvious to one skilled in the art to run a test to determine that the component functions appropriately in order to avoid destruction to the rest of the system.

The medical apparatus contains a data memory in which information serving for determining data is stored and taken from the data memory by the means for dealing with the problem on a problem-dependent basis (see col. 6, lines 45-50).

Babula et al.'914 teach the apparatus being assigned a data memory in which at least partially graphic information concerning the exchange of components which can be presented on a display unit of the apparatus is stored (see col. 16, lines 1-13 and see Figure 11).

Babula et al.'914 do not teach a self-test means for determining when a problem affecting the medical apparatus occurs.

In the same field of endeavor, Pech et al.'397 teach a self-test means for determining when a problem affecting the medical apparatus occurs (see col. 1, lines 47-67; col. 2, lines 24-67 and entire cols. 3-4; also in particular see col. 2, lines 1-6 clearly stating that this self-test means can be an integral component of the medical apparatus).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Babula et al.'914 and incorporated the teachings of Pech et al.'397 in order to identify the specific error of electrical or electromechanical components of the medical

apparatus, such as the specific portion of the medical component which is malfunctioning (see for motivation to combine in Pech et al.'397, col. 1, lines 27-36).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lebel'308 teaches an ambulatory medical apparatus with hand held communication device.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on 703 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.

Eleni Mantis Mercader
Primary Examiner
Art Unit 3737

EMM